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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. 1034

RICHARD E. MARINE,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS.

PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS FOR THE
DISTRICT OF COLUMBIA AND BRIEF IN SUP-
PORT THEREOF.

RICHARD E. MARINE,

Pro se.



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CONWAY P. COE, COMMISSIONER OF PATENTS.

**PETITION FOR WRIT OF CERTIORARI DIRECTED
TO THE UNITED STATES COURT OF APPEALS
FOR THE DISTRICT OF COLUMBIA.**

*To the Honorable the Chief Justice and the Associated
Justices of the Supreme Court of the United States:*

Your Petitioner, Richard E. Marine, respectfully prays for a writ of certiorari directed to the United States Court of Appeals for the District of Columbia to review a decree of that Court entered November 3, 1941, request for rehearing having been denied on December 3, 1941, or in the alternative to remand the case for further action. A certified transcript of the record in the case including the proceedings of such Court of Appeals, is furnished herewith, in accordance with Rule 38 of this Court. The time for filing this certiorari was extended ten days by this Court.

Summary Statement of the Matter Involved.

1. This is a suit under R. S. 4915 originally brought before the District Court of the United States for the District of Columbia asking that Court to authorize the Commissioner to issue a patent to Petitioner containing appealed claims 5 and 57 of his pending patent application, Serial No. 266, 340, filed March 31, 1928. These claims read as follows:

5. In a vehicle construction in combination; a body post having a face *in alignment* with the driver's line of vision past the same and a *door frame end member* substantially *within* the blind angle *subtended* by said post with the driver's eye.

57. In a vehicle construction, a body post *whose cross-sectional area extends to and is bounded on one side for substantially its full length by the driver's line of vision past said side*, and a window end frame member normally lying within the blind angle *subtended by the post* with the driver's eye. (Emphasis ours.)

2. Said application had been involved with one Wright in Interferences Nos. 61,642 and 61,643, the latter having been a consolidation of the three interferences. Wright had prevailed as to the single count of the first interference and had lost to petitioner the second interference involving four counts.

3. On appeal from the District Court to the United States Court of Appeals for the District of Columbia, that Court "Affirmed upon the findings of fact, conclusions of law, and opinions of the District Court". (51 U. S. P. Q. 540.)

4. In its opinion the District Court held, referring to the decision of the Court of Customs and Patent Appeals in Interference No. 61,642 (32 F. Sup. 236):

"It is considered that this interference count reads on the structure disclosed in plaintiff's claims Nos. 5

and 57, and it would, therefore, seem that such claims are disposed of adversely to the plaintiff by that litigation."

The count in Interference No. 61,642 read as follows:

"In a vehicle construction in combination, a body post provided with a front face substantially in alignment with the driver's forward line of vision past said post; and a windshield end frame member having a front face normally in substantial alignment with the front face of said body post."

We submit that this test of *res adjudicata* has no support under the authorities for reasons set forth hereinafter.

Aside from the propriety of this test for *res adjudicata* we submit that this ruling was improper because it ignored newly discovered evidence presented for the first time to the District Court, not having been previously available to Petitioner since it consisted in an admission made by Wright after termination of Interference No. 61,642 during the subsequent ex parte prosecution of his application which was not open to Petitioner until his patent issued thereon on November 24, 1936. This was after Petitioner had presented claim 57 to the Patent Office following termination of said interference and had contended that said claim, and also his original claim 5, distinguished over the subject matter of the Wright disclosure in a patentable sense and that therefore the subject matter of claims 5 and 57 was not *res adjudicata* against Petitioner, as indeed was found as a fact in Interference No. 61,642, but held not to be material to the issue therein, as will later appear.

That the District Court erred in its test adopted for determining *res adjudicata* was cited as error to the Court of Appeals (R. 119, IV, 1) and similarly the error in ignoring the newly discovered evidence was urged on appeal (R. 117, 19, 20, 21).

5. The District Court supplemented its ruling as to *res adjudicata* with the following additional finding [32 F. Sup. 236]:

"If, however, technically, the matter is not *res judicata*, the reasoning employed by the Court of Customs and Patent Appeals in that case compels the same conclusion. The Wright patent provides a front corner post assembly with no greater obstruction to vision and with more supporting strength than those previously employed. The drawings of the Wright patent show the front face of the assembly to be in substantial alignment with the driver's forward line of vision past said post. In so far as the claims of the petitioner relate to one face of the front corner post assembly, there is no critical difference. The plaintiff insists that the assembly disclosed by him in claims 5 and 57 has one face in alignment with the driver's vision, whereas the Wright structure is only substantially bounded by such line of vision, and even this quality is due to the 'accidental' draftsmanship of the drawings in the Wright patent. Laying aside the very complicated argument as to the geometry of the drawings, it suffices that the Wright specifications do show a substantial alignment on one face of the assembly, and that, for practical purposes, is all that plaintiff's structure accomplishes. So the conclusion is reached that the plaintiff is not entitled to the relief sought with respect to claims 5 and 57."

These findings ignore the findings of fact in Petitioner's favor in Interference No. 61,642 and also the newly discovered evidence above referred to. They were cited as error to the Court of Appeals (R. 117, 19, 20, 21; 119, 120, IV, 2, 3, 4, 5, 6, 7).

6. All of the above rulings of the District Court ignore entirely Petitioner's contention that claim 5 was dominated by Interference No. 61,643 in which Petitioner prevailed over Wright as to the subject matter of said claim, cited to

the Court of Appeals as error. (R. 119, 42, 43—it being noted that in line 2 of 42 the interference number 61,642 is a typographical error for 61,643, as clearly established by the fact that the latter interference only was consolidated with numbers 61,644 and 61,645).

7. All of the above questions involve the failure of the lower courts to give proper effect to applicable decisions of this Court and to the requirements of statutes involved. The requirements of R. S. 4888 and the decisions of this Court governing sufficiency of disclosure as laid down in *Permutit v. Graver*, 284 U. S. 52 and *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, and kindred decisions, and R. S. 4886 and the decision of this Court in *Mitchell v. Tilghman*, 86 U. S. 287, requiring utility as essential to disclosure, which the newly discovered evidence involving Wright's own admissions of lack of utility and, indirectly, lack of disclosure, definitely establish, are entirely ignored. Their consideration here necessitates a brief review of the facts established by the record.

8. The invention here at issue relates to an automobile front corner post assembly. Such an assembly is illustrated in Fig. 4 of Carlson patent 1671087 (R. 91). Such assembly comprises a fixed body post 36 extending from the body of the car to the roof and supporting the latter at its front end, together with a door window and frame member 29 which, when the door is closed, abuts the body post, and a windshield end frame member at the lower end of the windshield 38, also contact with the fixed body post 36. The assembly as a whole offers an obstruction to the driver's vision, indicated by the angle A, which is defined as the blind angle since objects beyond the post and lying within this angle are not seen by the driver. It was first pointed out by Emond, patent 1,622,098 (R. 87-89) that if the dimension of the assembly transverse to the driver's vision were

reduced to a dimension not exceeding two and a half inches, this being the interpupillary distance between the driver's two eyes, then the two parallel lines of vision past the assembly would enable him to see any object not smaller than two and a half inches, which became known as clear vision since it would enable the driver to see any object essential to safe driving.

The advantages of this construction for safety both to the occupants of the car and those using the streets and roads were manifest and the advance made in the art received wide acclaim. It had, however, one serious drawback, namely, all parts of the assembly had to be reduced to a minimum of size and the fixed body post itself became so small that it was unable successfully to sustain the loads placed upon it. This was admitted by Emond's assignee (R. 142) wherein it was stated that "one of the great problems has been to accomplish clear vision and still retain stability". Again, Carlson, a foremost body engineer and then vice president of the Dieterich Body Company, formerly makers of custom bodies for Packard, Cadillac and other high grade cars on which this post was installed (R. 61) states in a contemporaneous patent (R. 100, 2nd par.) that to incorporate in the vehicle the imperatively demanded qualities of clear vision presented a real problem if the corner post is to be made of adequate strength. Appellant testified (R. 47, 48, 50) that for many years he had attended automobile salons and shows and talked with these men or their representatives and was also familiar with the circumstances surrounding the attempt to embody clear vision in the New Day Jewett (R. 141) and that this car had failed (R. 49). These difficulties caused the public to give up its demand, then at its height, for clear vision and clear vision cars made by the production method practically disappeared from the market.

9. Petitioner conceived the idea that by departing from the prior practice of building the assembly with an over-all outline rectangular in cross-section and placed in the front corners of the car body with one pair of opposite faces substantially at right angles to the windshield and the other pair of faces parallel therewith, if the cross-sectional outline of the assembly were turned until two of its opposite sides were in alignment with the respective sides of the blind angle, then the fixed body post could be given any strength desired since it would be occupying the entire available space between the sides of the blind angle and there would be no waste space therein as in all prior constructions. Moreover, the assembly could be lengthened to any extent necessary for strength between the sides of the blind angle and longitudinally thereof. This is illustrated, for instance, in Petitioner's Fig. 6 (R. 131) described (R. 128) as follows:

"The construction shown in figure 6 differs from that of figure 3 mainly in that the windshield is moved forwardly, the recess 15" and the windshield frame 16" being made of triangular cross-section contour, as shown, in order to preserve the alignment of opaque members with the driver's line of vision."

It will be observed from Fig. 6 that this parallel arrangement of the sides of the fixed body post itself in alignment with the respective side lines of the driver's vision not only fills out all of the space in the blind angle throughout the length of the assembly but also that this outline is of the post *per se*, the window end frame member of the door and that of the windshield being inset in recesses in the body post itself, which recesses serve as corrugations, further strengthening the post (R. 124, folio 279).

10. Petitioner's original application as filed contained claim 14 (R. 129) which later became the sole count in In-

terference 61,642. This claim was first rejected by the Patent Office on the patent to Carlson 1,671,087 above described as typical prior art. The examiner's theory was that the limitation of this claim to "*substantially* in alignment with the driver's forward line of vision past said post" was met in Carlson's Fig. 4 (R. 91) in which the face of the arm or extension of his main post portion 36 made a substantial angle with the upper side of his blind angle A. On argument that claim 14, like claims 12 and 16, were patentable over Carlson for the reason that the line of vision in the latter passes through a corner or edge only—not through a face, (R. 133) the examiner allowed the claim and suggested it to one Wright for purpose of an interference (R. 149). Although Wright had never previously shown, described or claimed alignment of any face of the post with the driver's line of vision past it, he adopted the claim and an interference was declared.

11. Wright's drawings comprise two figures only, Figs. 1 and 2 which have been reproduced herein as Appendix A and Appendix B, showing these drawings as filed. This has been done because his original drawings reproduced (R. 177) fail to show the original vision lines due to faulty reproduction and his patent drawings (R. 173), have lines added thereto since the date of filing. In fact, his patent description is charged by Petitioner with containing new matter introduced by amendment and therefore it is submitted that only his original specification, reproduced with amendments made thereto apparent (R. 179-182), we submit, should be considered. Defendant has not relied upon these amendments in his previous arguments.

In Appendix A the characters *a* and F1 and in Appendix B the characters *a* and F2 have been added for ease of reference since Wright's disclosure makes no specific reference to these parts.

In Wright's Fig. 1 the vision line 23 here at issue makes a substantial angle a with the face F1 of the extension of his post 10. This angle a is of the same order of magnitude as the corresponding angle in Carlson's Fig. 4 between the up-side of his angle A and the face of his post extension or arm 39 and no tribunal has ever held that Wright's Fig. 1 supports the count of Interference 61,642 more than does Carlson.

In Wright's Fig. 2 the angle a between the face F2 of his post extension 14 and the side line of vision 23, constituting the adjacent side of his blind angle, is much smaller than in Fig. 1 and it is upon this figure that all tribunals have relied for disclosure of a face of the post extension in substantial alignment with the side 23 of the blind angle.

There is nothing whatever in Wright's disclosure about the angular relationship between the face F2 of the post extension in Appendix B and the side line of vision 23 and alignment is not even shown so that the drawing makes no suggestion of alignment, as called for by both of claims 5 and 57 here at issue. This fact was strongly testified to by the expert Mason (R. 26-27) or seriously challenged by Defendant. The disclosure, therefore, is at best accidental. It is accordingly submitted that in the rejection of claims 5 and 57 here at issue, which were not involved in the subject matter of Interference 61,642, as will hereinafter be shown, which claims call for *alignment* and not *substantial alignment*, the tribunals have not given proper effect to, in fact have ignored, the applicable decisions of this Court in *Permutit v. Graver*, 284 U. S. 52 and *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47 and kindred decisions.

Not only is this disclosure in Fig. 2 accidental but a consideration of the written description thereof and every action taken in Wright's amendments and arguments prior to the time that the Patent Office revealed Petitioner's disclosure to him by the declaration of Interference No. 61,642

establishes that said showing in Fig. 2 is both a draftsman's error and lacking in the utility demanded of a disclosure by R. S. 4886 (Appendix G). In the last paragraph (R. 179), Wright states that his description set forth at length that form of my invention which I had selected for illustration in the drawings accompanying and forming a part of the present specification. In the sentence immediately following (R. 180, beginning line 1) he states that the drawings themselves "show one form" of automobile body embodying my invention. He further states (R. 181, last sentence) that the vision line indicated at 24 is "the center line of vision". It is so shown in Fig. 1, but in Fig. 2 the angle made by the center line 24 with the side of the blind angle 23 is only half of that made by the same center line with the other side of the blind angle 22a. Further Wright's specification (R. 179, folio 1002) states that the average distance of the eye from the post is about twenty inches but the distance of the eye from the post in Fig. 2, when its lines of vision are extended, are only about eight or nine inches from the post (R. 29-30-179, folio 1002). That the line 24 is a center line is claimed in his original claims, e.g., 2 and 3 (R. 143) and by amendment, prior to knowledge of Petitioner's disclosure, he based a claim on the diamond shaped area of Fig. 1 and argued its patentability on this basis (R. 144-145) and in the same amendment he added an additional claim asserting that this area was substantially symmetrical about an axis (R. 145). Moreover every reference to Fig. 2 in his specification refers back to Fig. 1 for its geometry. It needs must follow, we submit, that Fig. 1 is the "one form" of his invention which he intended to disclose.

12. Lack of utility in Wright's Fig. 2 admitted by him. It is obvious from the above that by making the angle between the side line of vision 23 and the center line of vision 24 only one-half of what it should have been, Wright has

materially diminished the area given over to his post extension 14 and thereby weakened his post extension one-half. This is diagrammatically shown in Appendix D wherein his diamond shape of Fig. 1 is represented by the white area plus the grey area with apex *c* while his Fig. 2 is shown in white only. By the draftsman's error he has reduced the strength of his post extension 14 to the extent of the grey area. The four black corner areas indicated *a* in this figure show the additional strength which would have been added to his post assembly shown in Fig. 1 and represented in this diagram by the white plus the grey areas had he had the foresight to employ Petitioner's concept of alignment of two opposite sides of his assembly with the sides of the blind angle 22a, 23.

The diagram in Appendix C further analyzes these results. Here the heavy outer outline shows Wright's diamond shape of Fig. 1 with the center line 24 a true center line. Its face F1, as shown by the projected direction line B, comes far from passing through the eye of the driver which lies on the line 24 and no idea of alignment between this face and a driver's line of vision is possible. The inner face F2 is that of Wright's post extension shown in Fig. 2 and its line of direction D is also far removed from the direction of the driver's eye. If the area of the post extension is further reduced as shown by dotted lines having the direction extension G it would still not be in alignment with a line of vision from the driver's eye. Alignment could only be secured when the area of the post extension was reduced to zero, bringing the direction line in line with the driver's eye but destroying the post extension. Hence alignment in Wright emphatically spells lack of utility.

All of the above facts are in effect admitted by Wright himself in an argument submitted after termination of Interference No. 61,642 and not available to Petitioner in time to be urged before the Patent Office. It was therefore newly

discovered evidence of which the District Court should have taken notice.

This admission was made in an argument submitted to the Patent Office on December 4, 1935, to justify the showing in his Fig. 2 and is as follows:

“The mentioned diamond-shaped area (Fig. 1) is in practice *so much larger than is necessary for strength* that the Applicant's drawing (Fig. 2) shows *only the rearward half* (door side) *of the diamond*, with the inside or wind-shield face side *approximately in line with the line of vision of a person seated on that side of the car,*” (i. e. the driver). (Emphasis and parenthesis ours.)

Strange it is that Wright would intentionally weaken his post where his two and a half inch transverse dimensions would insure clear vision without it, where others had found it impossible to build a clear vision post of adequate strength to render clear vision practicable.

In failing to give consideration to this admission it is submitted that the District Court and the Court of Appeals also failed to give proper effect to applicable decisions of this Court as, for instance, in *Mitchell v. Tilghman*, 86 U. S. 287, 418, where it was said:

“Patent laws have for their leading purpose the encouragement of *useful* inventions. *Practical utility* is their object, and it would be strange if, with such object in view, the law should consider two things substantially the same which, practically, and in reference to *their utility*, are *substantially different.*” (Emphasis ours.)

13. *Construction given “substantial alignment” in Interference No. 61,642.* Petitioner throughout the progress of Interference No. 61,642 contended that “substantial alignment” meant essentially “alignment” of the character shown in his Fig. 6 and referred to in the written descrip-

tion of said figure, *supra*, and that therefore Wright did not disclose and could not make Petitioner's claim 14 (the sole count of said interference) because he showed an angle of deviation or divergence from true alignment and of the same order of magnitude as in Carlson's Fig. 4 (R. 91) on which said claim had been originally rejected, but afterwards allowed on the ground that "alignment" was not shown therein, nor results flowing therefrom similar to Petitioner's.

The Court of Customs and Patent Appeals, as had also the Patent Office tribunals, in contravention of R. S. 4904 (Appendix I) and the applicable decision of this Court in *Hill et al. v. Wooster*, 132 U. S. 693, and Patent Office Rule 94 (Appendix K), requiring invention as a condition precedent to an interference, refused to consider the meaning given the count necessary to patentably distinguish it over the Carlson patent, *supra*. The Court said:

"There is only one question before us, viz., the right of appellee to make the claim corresponding to the count here in issue. While appellant in his reasons for appeal assigns error by the board in refusing to consider prior art in determining the scope of the claim, that question cannot be considered by us. It is well established that we are not at liberty in a proceeding of this character to inquire whether the interpretation given a count by the Patent Office tribunals renders the count unpatentable over the prior art. *Marshall and Levandosky v. Ledwinka*, 21 C. C. P. A. (Patents) 728, 67 F. (2d) 495, and cases therein cited."

All tribunals in said interference denied appellant's contention that "alignment" and "substantial alignment" meant the same thing, namely, "alignment" but held on the contrary that

"the recitation of 'substantial alignment' must be construed to give some latitude" (R. 154, last sentence, R. 170, lines 2-5)."

The examiner of interferences also held that:

"It is true that Wright's post does not fill the space between the sides of the driver's blind angle and therefore Wright does not achieve the result achieved by Marine of maximum strength for a given obstruction to the driver. However, the count is not limited to a post which achieves that result. As far as the limitations are concerned the post might offer great obstruction to the driver's vision and be comparatively weak." (R. 152) (Emphasis ours).

The Court of Customs and Patent Appeals in adopting the "concurring decisions of the Patent Office tribunals" as the basis of its own decision (*Marine v. Wright*, 74 F. (2d) 996) affirmed these holdings. The Court of Customs and Patent Appeals, however, further found that:

"There does seem to be some inconsistency between appellee's Figures 1 and 2 as indicated by the projected lines of vision."

It needs must follow that the Court of Customs and Patent Appeals found that either Wright's Fig. 1 or his Fig. 2, or both, were erroneous. But in view of its affirmance of the Patent Office it must perforce have held that the range of "latitude" given the term "substantial alignment" was sufficient to read *on what Wright actually disclosed when the errors in the drawing were corrected. Otherwise it would have been the duty of the Court to determine the effect of these errors on Wright's right to make the count, which it failed to do*, as did also the District Court and the Court of Appeals when they laid "aside the very complicated argument as to the geometry of the drawings."

But while the Court of Customs and Patent Appeals could justify its failure to determine the extent and scope of the inconsistencies which it found to exist, on the ground of the latitude which, under its construction of the term

“substantial alignment”, it gave to the count in interference, the same justification, we submit, cannot be given the failure of the District Court and the Court of Appeals to determine the geometry of the drawings. This is for the reason that claims 5 and 57 here at issue are not susceptible of the wide latitude of construction given said count, as will presently appear. Moreover, necessity for determining the geometry of Wright’s drawings was, as we have shown above, non-existent, because Wright himself meanwhile had substantially admitted that the geometry of Fig. 2 was erroneous and that its true geometry was that of Fig. 1. We submit that it was the duty of the latter courts to consider this newly discovered evidence and that there was no basis whatever, in view thereof, of a holding of *res adjudicata* or even non-patentable difference over Wright in view of the fact that true alignment had already been found to be patentable over Carlson and by the same token was patentable over Wright’s corrected drawings.

That claims 5 and 57 are not susceptible of the wide latitude given the interference count follows from the following considerations.

Both claims 5 and 57 specify in effect a body post having a face *in alignment* with the driver’s line of vision past the same and a blind angle *subtended by said post* with the driver’s eye and claim 5 additionally specifies that the door frame end member lies substantially *within said blind angle*.

Alignment as taught by Appellant and called for by claims 5 and 57 effects the saving of waste space in the blind angle and increases post strength, without increased obstruction to vision. This is not true of Wright’s teaching.

Since the blind angle is stated in claims 5 and 57 to be subtended only by the body post, the entire width of the blind angle is given over to the post, alone, rather than to the entire assembly, as in Wright. Appellant’s post has

therefore also greater lateral strength than Wright's post 10.

The door end frame member 26 of Wright is not all within the blind angle subtended by the post as stated by claims 5 and 57 but itself subtends a very material part of the blind angle. The width and strength of the body post is correspondingly decreased.

Hence, none of these three features are at all disclosed by Wright or were or could have been adjudicated in Interference No. 61,642. His disclosure therefore cannot be *res adjudicata* against Appellant.

14. *Count 5 res judicata in favor of Appellant by reasons of decisions in his favor in Interferences 61,643-5 and estoppel under Rule 109.* The combination of claim 5 includes the door as an essential element of the combination. Such combination was not adjudicated in Interference No. 61,642, but was adjudicated in Interferences No. 61,643-5. The presence of the door frame in the combination introduces new and different problems from those of the windshield frame which latter only was adjudicated in Interference No. 61,642. *The door and its window frame must be continuously opened and slammed shut and the frame is subjected to heavy pressure of air which may cause its vibration when running fast.* It, therefore, presents specific problems not inherent in the windshield frame. The solution of these problems is well stated in the following sentence taken from Petitioner's specification, (R. 124-215):

“Thus a maximum of strength is imparted to the body post, while the door post, *since it is protected in closed or normal running position within the channel in the body post, also partakes of the strength of the latter.*”

Wright's disclosure and drawings fail utterly to show a door frame protected by the post as indicated, or in any

other way, and does not at all satisfy the terms of the claim.

Wright attempted to make count 1 of Interference No. 61,644 by a motion under Rule 109 made in Interference No. 61,643. This claim reads as follows (R. 6):

“A body post assembly comprising a *body post* provided with a face having a vertical channel therein and a *door window end frame member* positioned in said channel when the door is closed, said body post extending a substantial distance inwardly from said channel within the angle subtended by the outer portions of said assembly *with the driver's eyes and in substantial alignment with at least one side of said angle.*” (Emphasis ours.)

Wright's motion was denied and he did not appeal. The decision, therefore, became final and created an estoppel against him as to the door element of the combination. *The Newcomb Motor Company v. Moore, Commissioner of Patents*, 30 App. D. C. 464.

There were further counts 2, 3, involving the door window frame as counts in Interference No. 61,644, which Wright did not attempt to make (R. 6). Count 2 reads as follows:

“2. In a body post assembly, a body post having a vertical channel therein whose outer edges lie in substantial alignment with the driver's eye; and a *door window end frame member* lying substantially within said channel when the door is closed.”

Failure to make these counts 2 and 3 or similar counts appropriately modified created an estoppel against him under Patent Office Rule 109 (Appendix M).

Moreover, original claim 5 (R. 129) in substantially its present form was an original claim in Appellant's application and the failure of Wright to make it under the provisions of Rule 109 also created an estoppel against him (R. 129).

We, therefore, submit that claim 5 was not properly denied Petitioner on Wright's disclosure on the ground of estoppel but it is rather Wright who would be estopped to make said claim.

Jurisdiction.

This suit is brought under the provisions of Sec. 4915, R. S., U. S. Title 35, Sec. 63 U. S. Code and the jurisdiction of this Court is invoked under Title 28, Sec. 347 U. S. Code. The original decision of the Court of Appeals was rendered on November 3, 1941 (R. 186) and a petition for rehearing was denied on December 3, 1941 (R. 187). A motion by petitioner for additional time to file this petition was granted by this Court, through Chief Justice Stone, and such time was extended to March 13, 1942 (R. 189).

In support of such jurisdiction the decision *Baldwin v. Robertson*, 265 U. S. 168, 181 is cited.

The Questions Presented.

1. Is the fact that a count of a former interference is readable on the structure disclosed in a claim of a losing party a proper test of *res adjudicata* against the allowability of said claims to said party?

2. Where an interference was declared with a certain claim as its count only after the primary examiner, as a condition precedent to his right, under R. S. 4904 (Appendix I) and Patent Office Rule 94 (Appendix K), to put said claim in an interference, had given said claim a special construction rendering it patentably different from the disclosure of a particular patent on which it had been previously rejected when not given that construction, can an interference tribunal properly refuse consideration of the construction placed by the examiner on said claim when allowing it?

3. Can, after termination of the interference, the *ex parte* tribunals having jurisdiction revert to the original construction given the count by the primary examiner before the declaration of the interference, but a different construction from that given it by the interference tribunals in deciding priority, to support a holding of *res adjudicata* against a losing party as to other claims not adjudicated and limited definitely to the original *ex parte* meaning of the count which was adjudicated on a different meaning, particularly where said other claims define a structure not disclosed by the winning party?

4. Can a tribunal of the United States having proper judicial jurisdiction over patent cases ignore a manifestly applicable decision by this Court laying down rules to determine the sufficiency of disclosure required in applications, and patents resulting therefrom, by R. S. 4888 (Appendix H)?

5. Can a tribunal of the United States having proper judicial jurisdiction over patent cases ignore a manifestly applicable decision by this Court holding that a disclosure lacking in utility required by R. S. 4886 (Appendix G) is invalid as an anticipation?

6. Were petitioner's claims 5 and 57 properly denied him under the facts set forth in the statement of the case?

7. Were petitioner's claims 5 and 57 properly denied him under the principles involved in questions 1 to 5?

Reasons Relied On for the Allowance of the Writ.

1. Question 1 relates to the subject matter of paragraph 4 of the petition-statement. It is of paramount importance, we submit, to all inventors in general and to those who become involved in litigation in particular, of whatever sort, since the successful prosecution of a broad claim

could foreclose all protection on improvements of others in his art. It would become impossible for the loser of an interference, for instance, to obtain protection on the most specific type of improvement never contemplated by his adversary. Had the radio art been extensively developed during the life of the Bell Telephone patent it would appear that the rule stated by the District Court and Court of Appeals would have barred any protection on the most specific improvements in radio never contemplated by Bell.

Questions 2 and 3 bring into issue whether the rule of count construction in interferences wherein the construction given by the examiner in differentiating a claim over particular patents is ignored notwithstanding the requirement of R. S. 4904 that invention be found as a condition precedent to the determination of the question of priority of invention. This is also required by applicable decisions of this Court, *e. g.*, *Hill et al. v. Wooster*, 132 U. S. 693. Patent Office Rule 122, as amended (Appendix L, 2nd paragraph), recognizes this principle in the case where the claim of a patent is involved in interference and no reason is apparent why this same rule should not be extended to counts taken from pending applications and the failure to extend the rule is discriminatory. We submit that the existence of a patent renders the rule no more sacred than in the case of pending applications where the technical and harsh application of the rule of *res adjudicata*, as here, ignores the truth due largely to the confusion of issues resulting from a change in rules of the game during its progress. Applicants having pending applications rather than patents are liable to serious injury in passing the Scylla of different constructions of the same claim in a continuous proceeding only to be utterly destroyed by the Charybdis of *res adjudicata*, thereafter. Of the several hundred interferences finally decided on priority each year

the question of claim construction is generally involved and the rights to many important inventions are at stake. A patent claim is not "like a nose of wax which may be turned and twisted in any direction." If during the progress of an interference it appears that a former construction given the claim by the examiner in formulating the issue to be contested on priority cannot be accepted by a tribunal passing upon the question of priority in interference the interfering counts can and, we submit, should be re-formulated (*Podelsak v. McInnery*, 26 App. D. C. 399, 408). This Court has many times had occasion to modify the rules governing the practice in pending applications established by the tribunal having jurisdiction thereover. In the *Cornplanter case*, 90 U. S. 181, it overruled and abolished the practice of rejecting applications on prior abandoned applications; in *Miller v. Brass Co.*, 104 U. S. 350, and in *James v. Campbell*, 140 U. S. 356, it limited the time within which broadened reissue claims could be presented; in *Steinmetz v. Allen*, 192 U. S. 543, it declared invalid one of the rules of the Commissioner requiring division between claims for a process and claims for an apparatus; in *Chapman et al. v. Wintroath*, 256 U. S. 126, it held that the Commissioner would not restrict by rule the time within which claims of a patent could be copied for interference by an adversary to the period of one year after grant of the patent (under old statutes); and in *Milburn Co. v. Davis Co.*, it held that the filing of an application upon which a patent was granted fixed the effective date of the patentee's invention as of that date.

Relative to Question 4 it is submitted that the decision of the Court of Appeals herein does not give proper effect to the applicable decisions of this Court, *e. g.*, *Permutit v. Graver*, 284 U. S. 52; *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47; nor with respect to Question 5 to *Mitchell v. Tilghman*, 86 U. S. 287, 418. These are salutary

decisions necessary to the prevention of fraud and, we submit, that disregard of them should be discouraged.

Questions 6 and 7 involve the application of the above principles to the instant case. This case involves the item of safety by clear vision with adequate strength and these factors have been considered most important in the art. The District Court stated that improvements in this field should be stimulated and recognized (R. 111). A similar view was expressed by the Court of Appeals of the District of Columbia in *Meyers v. Coe*, 83 F. (2d) 708.

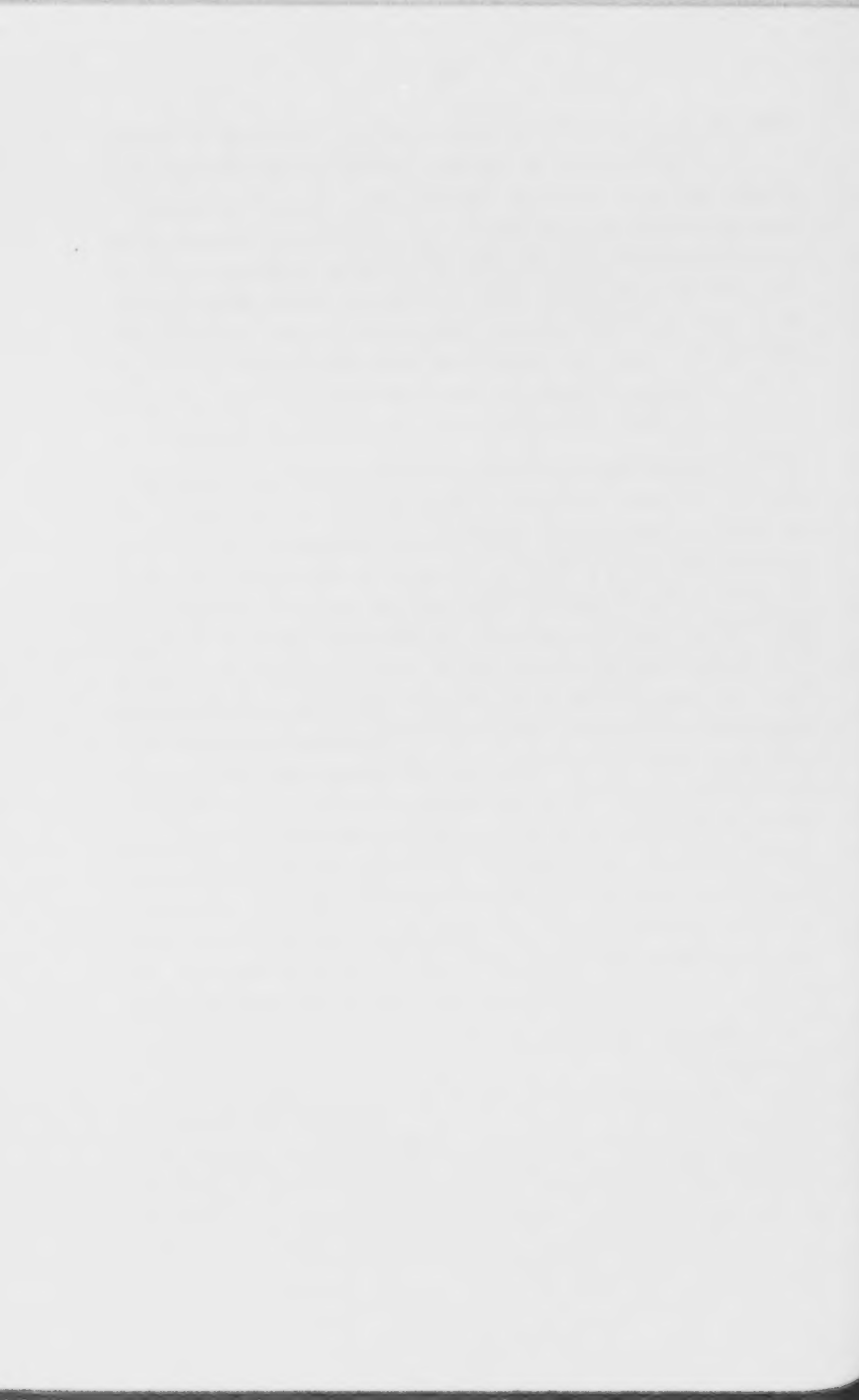
WHEREFORE, your petitioner, feeling himself aggrieved by the decree of the United States Court of Appeals for the District of Columbia, respectfully prays that a writ of certiorari be issued out of and under the seal of this Honorable Court, directed to the said United States Court of Appeals for the District of Columbia commanding that court to certify and send to this Court for its review and determination, on a day certain to be herein named, a full and complete transcript of the record and all the proceedings in the case, numbered and entitled on its docket, No. 7737, *Richard E. Marine, Appellant v. Conway P. Coe, Commissioner of Patents, Appellee*, and that said decree of the said United States Court of Appeals for the District of Columbia may be reversed by this Honorable Court and that petitioner may have such other and further relief in the premises as to this Honorable Court may seem meet and just, and your petitioner will ever pray.

RICHARD E. MARINE,
Pro se.

CHAS. S. GRINDLE,
Of Counsel.



PETITIONER'S BRIEF



SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941

No. 1034

RICHARD E. MARINE,

Petitioner,

vs.

CONWAY P. COE, COMMISSIONER OF PATENTS.

**SUPPORTING BRIEF ON PETITION FOR
CERTIORARI.**

I. Opinions of the Courts Below.

The opinion of the United States Court of Appeals for the District of Columbia in this case was rendered November 3, 1941, (R. 186) petition to rehear was denied December 3, 1941 (R. 187) and the opinion is reported in 51 U. S. P. Q. 540. The opinion of the District Court of the United States for the District of Columbia is reported in 32 Fed. Sup. 236 and also appears upon pages 109-111 of the transcript of record.

The opinion of the Court of Customs and Patent Appeals upon which the opinion of the District Court was based, is reported as *Marine v. Wright* in 74 F. (2d) 996.

II. Jurisdiction.

This suit is brought under the provisions of Sec. 4915, R. S., Title 35, Sec. 63, U. S. Code, and the jurisdiction of this Court is invoked under title 28, Sec. 347, U. S. Code.

In support of the jurisdiction the decision in *Baldwin v. Robertson*, 265 U. S. 168, 181 is cited.

III. Statement of the Case.

All that is material to the consideration of the questions here presented, with appropriate page references to the printed record, is believed to have been set forth under "Summary Statement of the Matter Involved" in the petition for writ of certiorari, in sections numbered 1 to 14, inclusive, to which reference is here made.

IV. Specification of Errors.

The United States Court of Appeals for the District of Columbia, following the findings of fact and law and the opinion of the District Court of the United States for the District of Columbia erred in:

1. Holding that the readability of a count lost in interference on the structure disclosed in claims not involved therein is a test of *res adjudicata* against the losing party (R. 119, IV, 1).

2. Not holding that petitioner's claims 5 and 57 are free from the charge of *res adjudicata* by reason of the outcome of Interference No. 61,642 (R. 117, 24).

3. Not holding that claims 5 and 57 patentably distinguish over Wright's actual disclosure (R. 117, 25).

4. Not condemning the practice of the Patent Office in adjudicating a count which had not been found to be patentable, due to the fact that it was given a different construc-

tion in interference from that which the primary examiner had found allowable (R. 118, 31-36).

5. Resorting to the construction given petitioner's original claim 14 in finding it patentable over Carlson rather than the construction given it in interference in determining *res adjudicata* (R. 119, 37-39).

6. Failing to consider newly discovered evidence in the form of Wright's admission in his application record after termination of Interference No. 61,642, establishing lack of utility in his disclosure in Fig. 2, solely relied upon as anticipation by all tribunals (R. 117, 19-22), and therefore failing to give proper effect to applicable decisions of this Court.

7. Failing to consider this newly discovered evidence together with other evidence in Wright's record fully establishing accident and error in Wright's Fig. 2 (R. 116, 117, 13-21), and therefore failing to give proper effect to applicable decisions of this Court.

8. Holding that there is no critical difference between alignment and substantial alignment (R. 120, 4).

9. Holding that the geometry involved in Wright's case should be laid aside (R. 120, 5).

10. Holding that for practical purposes plaintiff's structure accomplishes no more than the substantial alignment of Wright (R. 120, 6).

11. Not holding that claim 5 is *res adjudicata* in favor of petitioner by reason of the adjudication in his favor in consolidated interference No. 61,643 (R. 119, 42-43), and also by the failure of Wright to make said claim, under Patent Office Rule 109, which was in petitioner's application as filed and during the progress of the interference (R. 119, 43).

12. Not allowing claims 5 and 57 to petitioner.

V. Argument.

Petitioner's position relative to errors 1 and 2 is substantially the same as that to question 1 of the petition (p. 18, *supra*) and is stated under 1, page 19 of said petition.

His position with reference to errors 3, 8, 9 and 10 is set forth on pages 12 to 16 of the petition.

His position relative to errors 4 and 5 is set forth beginning in the middle of page 20 and ending at the bottom of page 21 of the petition.

His position as regards error 6 is set forth under 12, beginning page 10 and ending on page 12 of the petition.

His position relative to error 7 is based on the facts set forth under 11 on page 8 of the petition and extending to 12 on page 10.

As there set forth Wright's application disclosed two figures, Fig. 1 and Fig. 2, that were stated in the specification to be the same but which actually differed materially on the windshield side of the assembly in the angular relationship of the parts to each other in the respective figures. Wright's record before declaration of Interference No. 61,642 never described or claimed the angular relationship shown on the windshield side of Fig. 2 although he had broadly shown, described and claimed that of Fig. 1, having claimed the cross-sectional area of his assembly as being diamond-shaped and symmetrical about the "center" line 24, none of which description was consistent with or could be reconciled with the windshield side of his Fig. 2. Nevertheless his Fig. 1 was never relied upon in Wright's arguments or by any tribunal in Interference No. 61,642 to support the count thereof, and indeed to have done so might have brought the interfering count under the disclosure of Fig. 4 of Carlson over which the count had been distinguished. However, this may be it is certain that there is

no description of Wright's Fig. 2 fixing the value of the angle a therein on the windshield side of his assembly (Appendix B). The expert Mason so testified (R. 26-27) and the original specification and claims clearly establish the fact.

All tribunals below, in relying only on the Fig. 2 drawing to support their conclusion and in refusing to consider the charges of accident and error in said figure, much less Wright's own admission after termination of Interference No. 61,642, have ignored the principles established in applicable decisions of this Court governing the determination of disclosure under R. S. 4888 and holding that a drawing alone is not a sufficient disclosure. Much more is this true where its accuracy has been impeached.

As stated by the Court in *Permutit v. Graver*, 284 U. S. 52, 60:

"Moreover, while drawings may be referred to for illustration and may be used as *an aid in interpreting the specification or claim*, they are of no avail where there is an entire absence of description of the alleged invention or a failure to claim it." (Citing authorities.)

The still more recent decision of this Court in *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47, is directly in point. In that case there was involved the question of whether or not a drawing showing a piston provided with webs and a split skirt, as to which the description emphasized the property of rigidity, was flexible within the meaning of that term as employed by another who showed in his drawings substantially the same structure but explicitly described its property as flexible. While admitting that the first structure, though described as possessing rigidity would inherently possess some flexibility, the Court held that the absence of a written description emphasizing this property

and its purpose rendered the disclosure of the first structure insufficient. The Court said (p. 58):

“The properties of any given material are many and diverse. The antithetical qualities of rigidity and flexibility of a structure are not absolute but relative; it may be more rigid than some and more flexible than others; too rigid for some purposes and too flexible for others. The one quality may be increased and the other diminished by choice of materials from which the structure is made and by variation in its proportions. *If invention depends on emphasis of one quality over the other, as the court below found was the case with the laterally flexible webs in the Gulick device, the statute requires that emphasis to be revealed to the members of the public, who are entitled to know what invention is claimed. That is not accomplished either by naming a member having inherent antithetical properties or by ascribing to it one property when the other is meant.*” (Italics ours.)

This case bears another very striking resemblance to the instant case in that the question of estoppel by reason of adjudications in prior interferences was at issue. The Court in effect held that the *requirements of Revised Statute 4888 for explicit written description were of greater force than prior adjudications in interferences*. The Court said (pp. 59, 60):

“We recognize the weight to be attached to the determinations in the interference proceedings in which the Court of Appeals of the District of Columbia and the Court of Customs and Patent Appeals sustained the Gulick amendments. Cf. *Radio Corporation v. Radio Laboratories*, 293 U. S. 1, 7. But the decisions in those cases are not controlling here. So far as the courts relied on the inherent flexibility of the webs to supply the feature of lateral flexibility omitted from the Gulick description *they ignored the principle recognized in Permutit v. Graver Corporation, supra*, and

Powers-Kennedy v. Concrete Co., supra. So far as they relied on the drawings to supply the omission they disregarded the fact shown both by inspection and by the evidence presented here that the drawings do no more to point to Gulick's invention than does the fact of inherent flexibility. We conclude that respondent can take no benefit from the flexible web element added by amendment to the Gulick application."

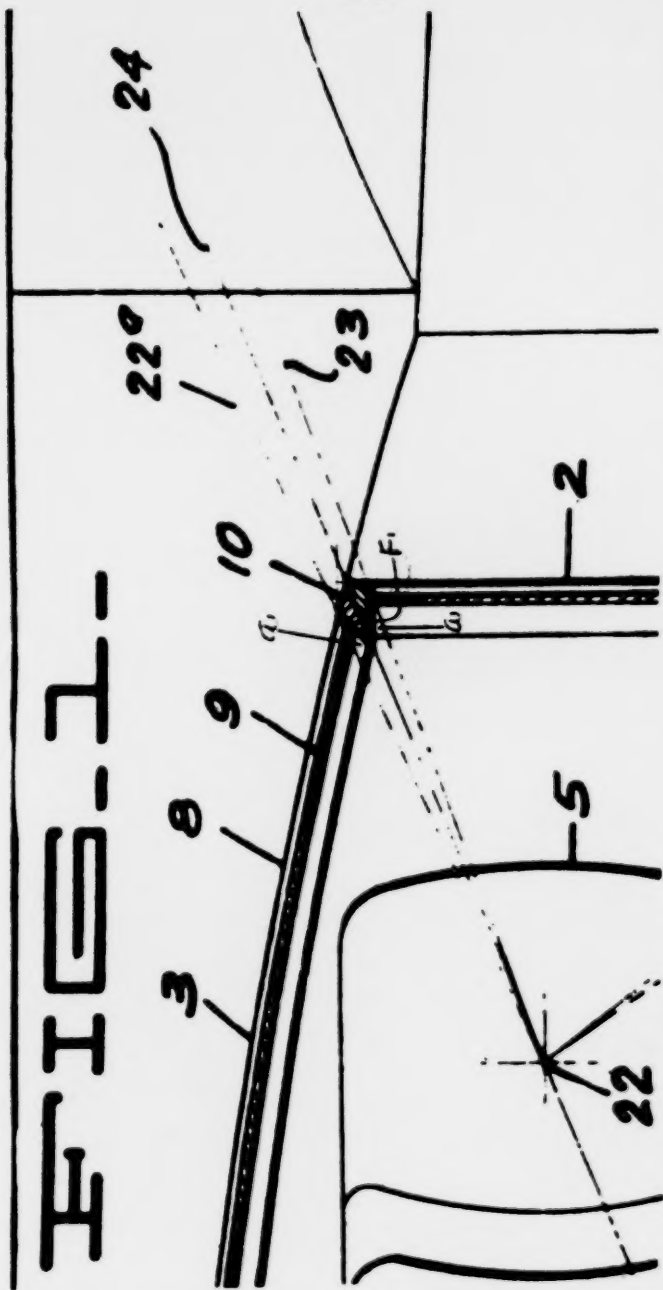
Petitioner's position relative to error 11 is set forth under 14, beginning page 16 and ending at the top of page 18 of the petition.

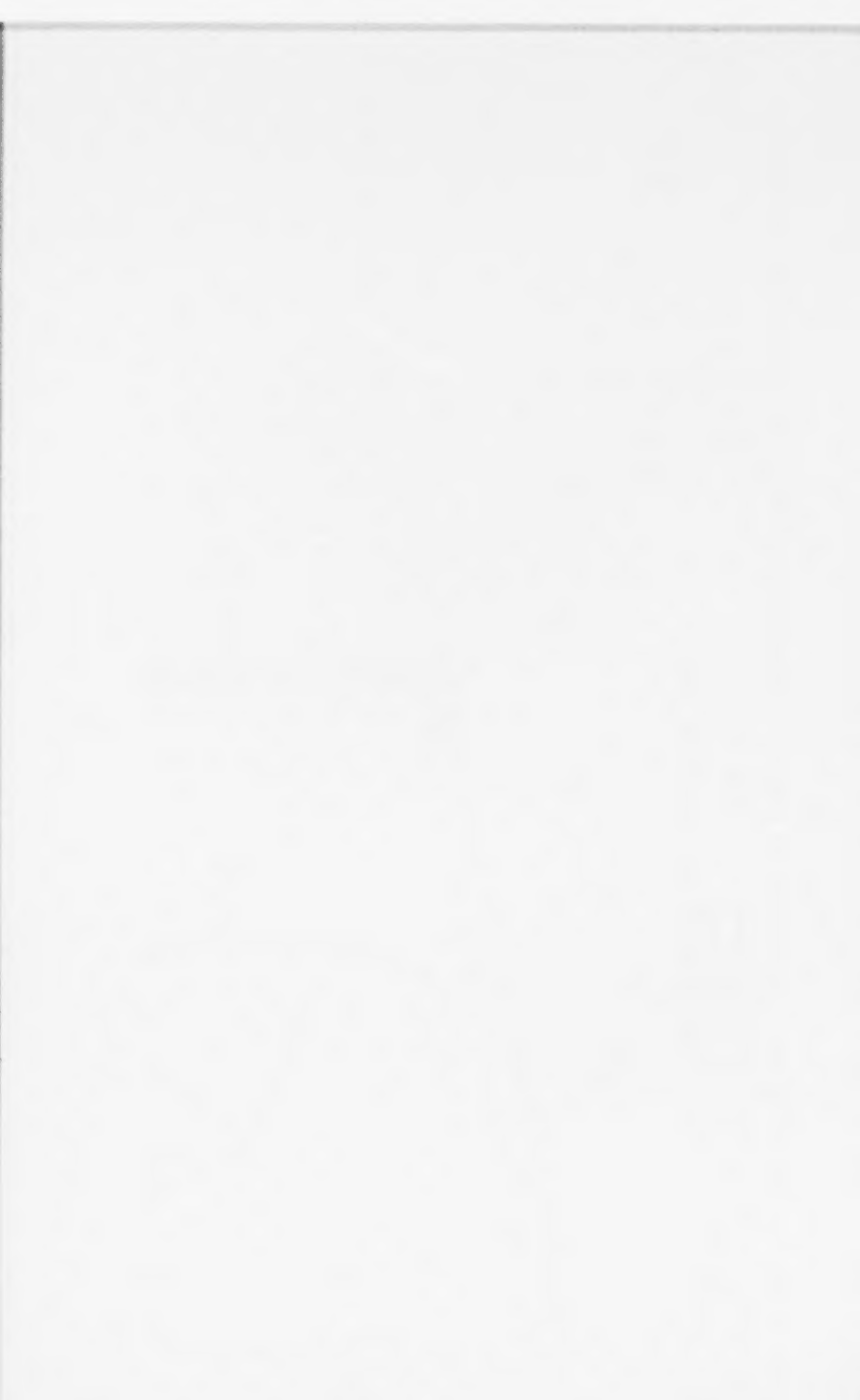
It is respectfully submitted, therefore, that this Court should take jurisdiction of this case, reverse the decree of the United States Court of Appeals for the District of Columbia and direct that a new decree be entered by the District Court of the United States for the District of Columbia, authorizing the Commissioner of Patents to issue a patent to Petitioner.

RICHARD E. MARINE,

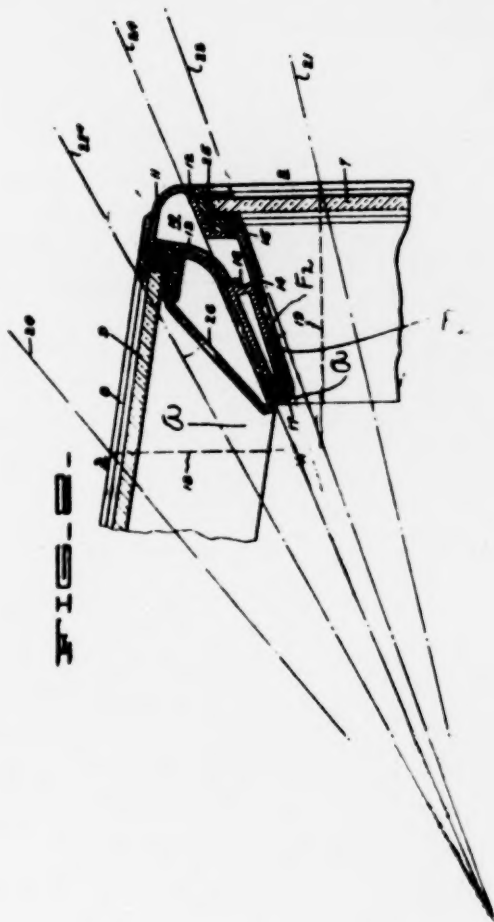
pro se.

CHAS. S. GRINDLE,
Of Counsel.





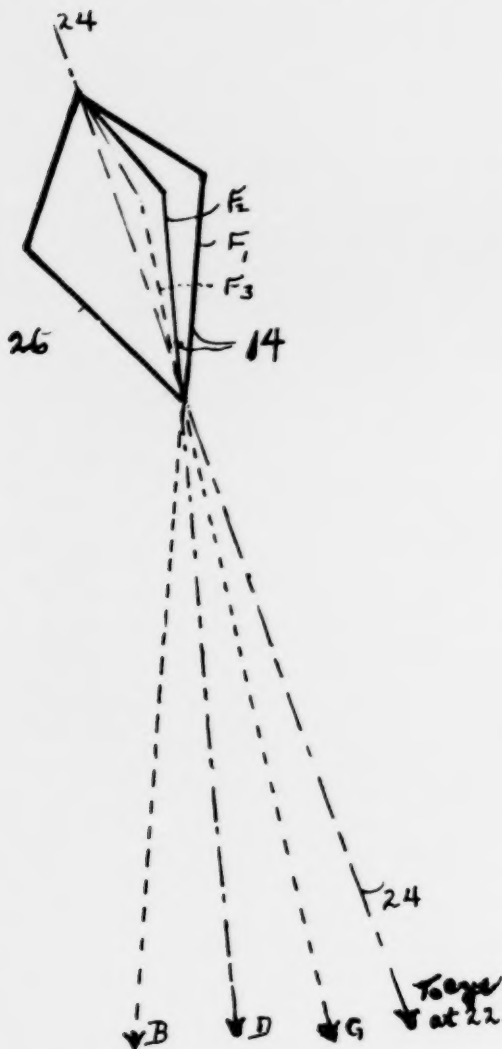
APPENDIX B



EDWARD A. WRIGHT
White & Wright
 PATENT ATTORNEYS



APPENDIX C





APPENDIX D

FIG. A



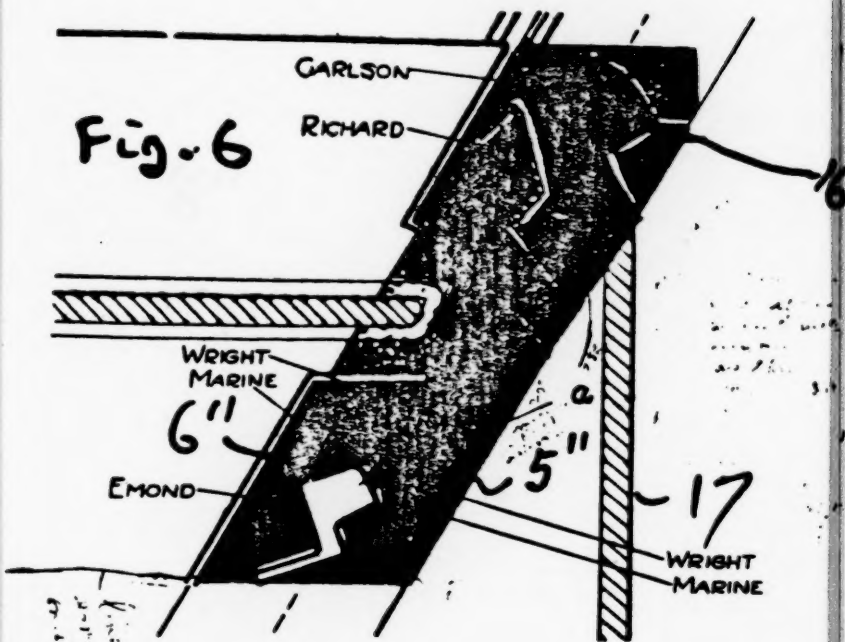
FIG. B





APPENDIX E

EXHIBIT #10





APPENDIX F.

R. S. 483

(U. S. C., title 35, sec. 6.) The Commissioner of Patents, subject to the approval of the Secretary of Commerce, may from time to time establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

APPENDIX G.

R. S. 4886

(U. S. C., title 35, sec. 31.) Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor.

APPENDIX H.

R. S. 4888

(U. S. C., title 35, sec. 33.) Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, con-

struct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. * * *

APPENDIX I.

R. S. 4904

(U. S. C., title 35, sec. 52.) Whenever an application is made for a patent which, in the opinion of the commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, within such time, not less than twenty days, as the commissioner shall prescribe.

APPENDIX J.

R. S. 4915

(U. S. C., title 35, sec. 63.) Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the Board of Appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section, may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall

authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of the law. In all cases where there is no opposing party a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

APPENDIX K.

Patent Office Rule 94

Interferences will be declared between applications by different parties for patent or for reissue when such applications contain claims for substantially the *same invention* which are allowable in the application of each party, and interferences will also be declared between applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved: Provided, That where the filing date of any applicant is subsequent to the filing date of any patentee, the applicant shall file an affidavit that he made the invention in controversy before the filing date of the patentee. * * *

APPENDIX L.

Patent Office Rule 122 (as amended)

Motions to dissolve an interference (1) alleging that there has been such informality in declaring the same as will

preclude the proper determination of the question of priority of invention, or (2) denying the patentability of an applicant's claim, or (3) denying his right to make the claim, or (4) if the interference involves a design patent or an application, alleging that there is no interference in fact and also motions to shift the burden of proof, should contain a full statement of the grounds relied upon and should, if possible, be made within the time fixed by the examiner of interferences, not less than thirty days, after the statements of the parties have been received and approved. Such motions and all motions of a similar character, if in the opinion of the examiner of interferences they be in proper form, will be heard and determined by the primary examiner, due notice of the day of hearing being given by the office to all parties. If in the opinion of the examiner of interferences the motion be not in proper form, or if it be not brought within the time specified and no satisfactory reason be given for the delay, it will not be considered and the parties will be so notified.

At a hearing on a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file shall be referred to for the purpose of construing the issue. No interlocutory appeal from the decision on a motion to shift the burden of proof will be entertained, but the matter may be reviewed at final hearing and on appeal.

APPENDIX M.

Rule 109

An applicant involved in an interference may, within a time fixed by the examiner of interferences not less than thirty days after the preliminary statements (referred to in rule 110) of the parties have been received and approved, or if a motion to dissolve the interference has been brought by another party, within thirty days from the filing thereof, on motion duly made as provided by rule 153, file an amendment to his application containing any claims which in his opinion should be made the basis of interference between himself and any of the other parties. * * *



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In the Supreme Court of the United States

OCTOBER TERM, 1941

No. 1034

RICHARD E. MARINE, PETITIONER

v.

CONWAY P. COE, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE DISTRICT OF
COLUMBIA

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The memorandum opinion of the United States District Court for the District of Columbia (R. 109) is reported in 32 F. Supp. 236. The *per curiam* opinion of the United States Court of Appeals for the District of Columbia (R. 186) is reported in 123 F. (2d) 340.

JURISDICTION

The judgment of the United States Court of Appeals for the District of Columbia was entered on November 3, 1941 (R. 187). A petition for re-

hearing was denied on December 3, 1941 (R. 187). The time within which to file a petition for certiorari was extended by Chief Justice Stone to March 13, 1942 (R. 189). The petition for a writ of certiorari was filed on March 13, 1942. The jurisdiction of this Court is invoked under Section 240 (a) of the Judicial Code, as amended by the Act of February 13, 1925.

QUESTIONS PRESENTED

1. Whether the record contains evidence to support the conclusion of the District Court that petitioner's patent claims were disclosed in the prior art.

2. Whether an unsuccessful party in an interference proceeding may subsequently obtain a patent upon claims substantially the same as those involved in the interference proceeding.

STATUTE INVOLVED

Revised Statutes, sec. 4915, as amended by the Act of March 2, 1927, sec. 11, 44 Stat. 1335, and the Act of March 2, 1929, sec. 2 (b), 45 Stat. 1475 (35 U. S. C. § 63) provides:

Whenever a patent on application is refused by the Commissioner of Patents, the applicant, unless appeal has been taken from the decision of the board of appeals to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided, in which case no action may be brought under this section,

may have remedy by bill in equity, if filed within six months after such refusal; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication and otherwise complying with the requirements of law. In all cases where there is no opposing party, a copy of the bill shall be served on the commissioner; and all the expenses of the proceedings shall be paid by the applicant, whether the final decision is in his favor or not. In all suits brought hereunder where there are adverse parties the record in the Patent Office shall be admitted in whole or in part, on motion of either party, subject to such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court may impose, without prejudice, however, to the right of the parties to take further testimony. The testimony and exhibits, or parts thereof, of the record in the Patent Office when admitted shall have the same force and effect as if originally taken and produced in the suit.

STATEMENT

The petitioner is the owner of Patent Application Serial No. 266,340, filed March 31, 1928, which includes claims 5, 57, and 58 (R. 2, 13). These claims relate to the construction of body posts at the ends of an automobile windshield with faces "in alignment" with the driver's lines of vision in order to give maximum body strength and minimum vision obstruction (R. 4, 13, 16). The prior art disclosed that obstruction to vision was virtually eliminated by a front corner post which did not exceed two and a half inches in width, the normal distance between a person's eyes (R. 20, 21). The reduction of the corner post to this width, however, had a weakening effect (R. 49-50). The petitioner's claimed invention consists in extending the construction of the post along the driver's lines of vision and thereby increasing its strength without increasing the obstruction to vision (R. 3). Claims 5 and 57 relate to posts having one face in alignment with the driver's line of vision; claim 58 relates to a post having two faces in alignment with the driver's lines of vision (R. 4, 13). The latter claim was sustained in the District Court, and is not now in issue (R. 110-111, 113). Only claims 5 and 57 are involved here (Pet. p. 2).

Petitioner's application was involved in interference with an application of Wright, which has now matured into patent No. 2,061,788, on a count which described a post having a front face

“substantially in alignment” with the driver’s forward line of vision, and a windshield end frame member substantially in alignment with the front face (R. 2-3, 6, 14). Petitioner was notified in the declaration of the interference that his claim 5 disclosing a body face “in alignment” with the driver’s line of vision would be held subject to rejection as unpatentable in the event priority was awarded to an adverse applicant (R. 136). The Patent Office tribunals awarded priority to Wright (R. 151-156, 166-170) and the decision was affirmed by the United States Court of Customs and Patent Appeals. *Marine v. Wright*, 74 F. (2d) 996. Thereafter, the claims here involved were rejected by the examiner in view of the prior determination in the interference proceeding, and on the ground that the claims were anticipated by Wright’s disclosure (R. 134-137). This rejection was affirmed by the Board of Appeals of the Patent Office (R. 4-5, 14), whereupon the petitioner filed an action under section 4915 of the Revised Statutes in the District Court of the United States for the District of Columbia (R. 1-13).

The District Court rejected the claims on the grounds that they were substantially the same as those adjudged adversely to the petitioner in the prior interference, and that the evidence in the present proceeding, independently considered, required the conclusion that the claims were disclosed by the prior art (R. 109-113). On appeal by peti-

tioner to the Court of Appeals for the District of Columbia, the judgment was affirmed upon the findings of fact, conclusions of law, and opinion of the District Court (R. 186).

ARGUMENT

The decision of the court below is clearly correct. The question of invention is one of fact. *United States v. Esnault-Pelterie*, 299 U. S. 201, 205. The Patent Office and the District Court have both found that the substance of petitioner's claims were disclosed in the prior art (R. 4-5, 14, 109-113), and the findings are supported by substantial evidence. Wright's patent application described the front face of his post as "extending rearwardly at an angle in line with the normal line of vision of the automobile driver" (R. 174, 180), a disclosure which plainly anticipated the petitioner's claims and which, by its terms, negatives the suggestion (Pet. 9-10) that Wright's illustration of "substantial alignment" in the accompanying drawing was merely accidental. The suggestion (Pet. 12-14) that the claim of "alignment" described in petitioner's application is narrower than and not included within the prior disclosure of "substantial alignment" is without merit. The principle was disclosed and the difference, if any, in the degree of alignment embodied in petitioner's claims involves no element of novelty or invention, particu-

larly since, as petitioner testified (R. 51), "in none of these cases can you fix an absolute position of the driver's eye."

Moreover, petitioner's claims are foreclosed by the adverse decision in the interference proceeding by "an adaptation for patent cases of the basic doctrine of *res judicata*, estoppel by judgment." *Daniels v. Coe*, 116 F. (2d) 941, 943 (App. D. C.). Virtually the same arguments presented by petitioner in his application for a writ and in the court below were made and rejected in the prior interference proceeding. *Marine v. Wright*, *supra*. The distinction between the present claim of "alignment" and that of "substantial alignment" involved in the interference is immaterial. Moreover, the decision in interference is conclusive on all claims that could have been presented, a rule which is peculiarly applicable here in view of the notice to petitioner in the declaration of interference that the claim of "alignment" in claim 5 would be held subject to rejection in the event of an adverse decision in the interference proceeding. Cf. *Daniels v. Coe*, *supra*, at p. 943.

CONCLUSION

The decision of the court below rests upon findings of fact which are supported by the evidence. There is no conflict of decisions, and no question of general importance. It is therefore respectfully

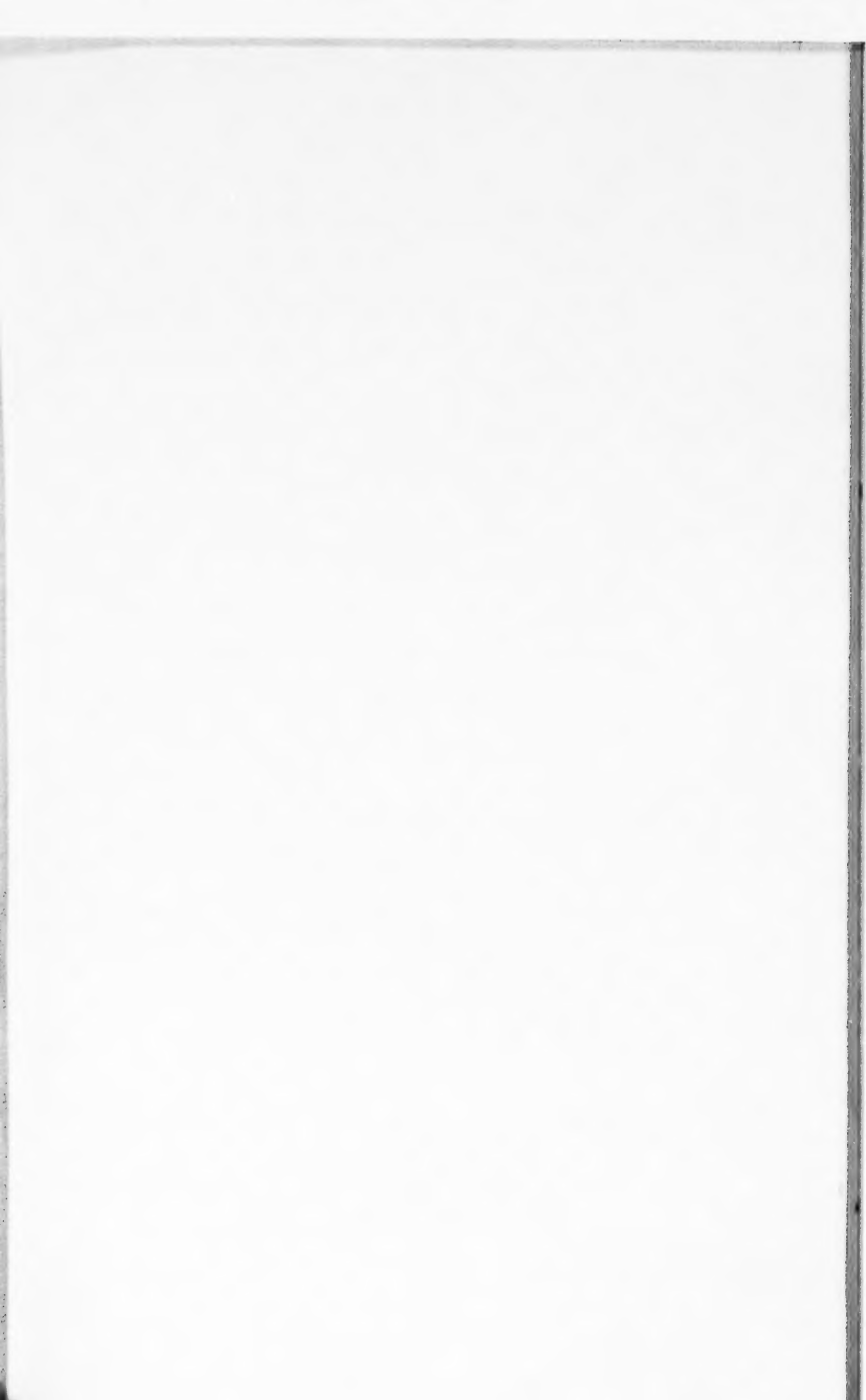
submitted that the petition for a writ of certiorari should be denied.

CHARLES FAHY,
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FRANCIS M. SHEA,
Assistant Attorney General.

MELVIN H. SIEGEL,
MORTON LIFTIN,
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W. W. COCHRAN,
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CHARLES ELMORE CROPLEY
CLERK

Supreme Court of the United States

OCTOBER TERM—1941.

No. 1034.

RICHARD E. MARINE,

Petitioner,

VS.

CONWAY P. COE, Commissioner of Patents.

REPLY BRIEF FOR PETITIONER.

RICHARD E. MARINE,

Pro se.

CHARLES S. GRINDLE,

Of Counsel.



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Supreme Court of the United States

OCTOBER TERM—1941.

No. 1034.

RICHARD E. MARINE,

Petitioner,

VS.

CONWAY P. COE, Commissioner of Patents.

REPLY BRIEF FOR PETITIONER.

Note: P. B. as herein used refers to "Petition and Brief" for Petitioner.

R. B. as herein used refers to "Brief for the Respondent in Opposition".

Appendixes D and E are reproduced herein because the former reproductions were imperfect.

The petitioner and the respondent do not seem to agree as to the questions presented on this petition. On pages 18 and 19 of the petition, these are stated to be seven in number, of which the first five are specific. On page 2 of the respondent's brief, however, these seven are wholly ignored, and two others are substituted that appear to be entirely beside the point.

The Petitioner's Question 1. The Issue Is Not *Res Judicata* As Against the Petitioner, But Claim 5 Is *Res Judicata* In Favor of the Petitioner.

On page 7 of the respondent's brief, it is stated that the issue is *res judicata*, reference being to Interference No. 61,642 alone. But the only basis for the

holding on this ground is the confused and untenable test of *res judicata* adopted in the District Court's opinion at the bottom of page 2 and the top of page 3 of the petition. This test is challenged by the first question presented, on page 18 of the petition for the reasons stated under 1, on pages 19 and 20.

The District Judge's reasoning, it is submitted, was wrong. The matter is not *res judicata* because the subject matter in said interference is not the same as that involved in the present proceeding. The count in said interference did not specify nor do Wright's specification or drawings disclose the three features of the claims here at issue, specified in the last four paragraphs, page 15, continuing down to "14" on page 16 of the petition. It was in effect so held in said interference (P. B. 14, first quotation) and this finding of fact is here *res judicata* in favor of petitioner. The respondent's brief affords no help whatever toward the solution of the problem presented by petitioner's question 1.

As explained on page 3 of the petition, moreover, the principle of *res judicata* would not be applicable in any event, because of newly discovered evidence, which had previously been fraudulently suppressed by Wright and which did not become available to the petitioner until long after the interference had terminated.

This new evidence was constituted of an admission by Wright himself as to the lack of utility of his Fig. 2 post, which figure is solely relied upon by respondent to anticipate claims 5 and 57 here at issue. This post Wright has now admitted to be weak and not strong (P. B. 12). Attention is invited to the paragraph numbered 7 on page 5 of the petition, and to the bottom of page 10 and pages 11 and 12. The fifth question, printed on page 19, bears

on this. It is submitted that this admission voids Wright's disclosure as an anticipation of claims 5 and 57 and is alone conclusive of the patentability of the claims at issue.

In reality, however, the issue as to claim 5 is *res judicata* in favor of the petitioner, as explained under item 6, pages 4 and 5 of the petition and also pages 16 and 17.

The record shows that petitioner has invented a strong post, as distinguished from the admittedly weak Wright post. The record shows also that the claim involved in Interference No. 61,642, *Marine v. Wright*, was originally allowed to the petitioner, before the interference was declared, as specifying a strong post, thus defining over the prior art. The record shows that, ignoring this meaning thus assigned to the claim, it was later, in the interference, under well established interference rules, construed as broadly as possible, including even the prior art weak posts and the Wright weak posts.

The Petitioner's Question 2. The Petitioner Is the Victim of Technical Rules.

The second question, presented on page 18 of the petition, therefore, is whether, after a claim had been construed to be patentable over the disclosures of prior patents (as explained in the paragraph numbered 10, on pages 7 and 8 of the petition), the meaning thus assigned to the claim may then be ignored for interference purposes. This is explained, with a quotation from the decision of the Court of Customs and Patent Appeals, on page 13 of the petition. It was only because of the ignoring of the meaning originally given to petitioner's original claim 14,

necessary to render it patentable over the prior patent to Carlson, that it became the count of the Wright Interference No. 61,642 (see also the bottom of p. 12 and p. 13).

With the new meaning thus assigned to the count, it became unpatentable over the prior art, but since, as held in the quotation just referred to, the question of patentability is not considered in interferences, priority was awarded to Wright. This practice gives no weight to the applicable decision of this Court in *Hill et al. v. Wooster*, 132 U. S. 693, as explained on pages 13, 20 and 21 of the petition and conflicts with the practice in the Sixth Circuit as stated in *Clements v. Kirby*, 274 Fed. 575, 581, 582.

The Petitioner's Question 3. This Court Has It In Its Power to Change These Unjust Technical Rules.

Once the interference was over, the petitioner presented a new claim (57 here at issue) that would define over the unpatentable count and over Wright's disclosure by embodying the distinctions found to exist between Wright's disclosure and petitioner's in Interference No. 61,642 (P. B. 14, first quotation); the omission of the word "substantial", which had been responsible for all the conclusion up to that time, and specifying that the post, alone, subtended the blind angle, thus giving over to it the full width of the blind angle to obtain maximum lateral strength, the door or window end frame member lying entirely within said angle, overcame the difficulty (P. B. 15, 16). This word "substantial", it had been held in the inter partes proceedings, rendered the count in interference broad enough not to be restricted to

maximum strength posts, but to also include weak posts (P. B. 14, first quotation). The new claim was carefully drafted to cover only petitioner's strong post—not disclosed by Wright. The new claim, however, was then held to be *res judicata* in view of the outcome of the interference. This raises the third question, presented on page 19 of the petition.

This is an important question because, through these technical rulings, the plaintiff has been deprived of a patent for maximum-strength-post invention that he alone made, and that Wright, in his accidental disclosure, did not make, as explained on pages 14 (last paragraph) to 16 of the petition. The effect of this action was to reject petitioner on his own invention, for had the interference never existed and had its unpatentable count never been the basis of an award of priority to Wright, the Wright patent when issued would never have been held an anticipation of claim 57, more than would Carlson (P. B. 9, first paragraph) over which even the imperfect interference count, as construed by the examiner before the interference, had been allowed (P. B. 20, 21, 22).

The Petitioner's Questions 4 and 5. This Court's Prior Decisions Have Not Been Followed.

The fourth and fifth questions, presented on page 19 of the petition, refer to matters of sufficiency of disclosure and utility fully discussed on pages 5, 9 to 12, 21 (last paragraph), and 26-29. These are most important questions because disregard of them results in the encouragement of fraud.

The Petitioner's Questions 6 and 7. Application of the Above Principles to Petitioner's Case.

These questions are considered generally on page 22 of the petition and are fully answered specifically in the consideration of the previous questions.

Respondent's Question 1. Does the Record Evidence Support the Conclusion of the District Court that Claims 5 and 57 are Disclosed In the Prior Art, i. e., Wright.

For support of his answer in the affirmative respondent, on page 6 of his brief, states that the patent application of Wright, who had been involved in several interferences with petitioner, "described the *front face* of his post as 'extending rearwardly at an angle in line with the normal line of vision of the automobile driver' * * * which, by its terms, negatives the suggestion that Wright's illustration of 'substantial alignment' in the accompanying drawing was *merely accidental*." (Italics ours.)

It described no such thing. The District Judge refused to accept this argument. No final decision on priority of any tribunal in Interference No. 61,642 accepted Wright's repeated arguments to the same effect. Wright never disclosed petitioner's invention and therefore never disclosed its principle as asserted by respondent on the same page of his brief. The only reason that Interference No. 61,642 was declared was because of a draftsman's error, as explained on pages 8 to 14 of the petition. Respondent's quotation from Wright's application is partial only. The complete quotation (R. 180, fol. 1004) is

given in the first column below. In the second column is quoted a parallel statement also occurring in Wright's original specification as filed (R. 181, last sentence, ending on 182):

<p>“The pillar 10 is formed with a corner portion 11 having sides 12 and 13 and an <i>elongated extension 14</i> extending rearwardly</p>	<p>“The front pillar may be described as <i>a flat pillar of narrow width</i> positioned</p>
---	--

<p><i>at an angle in line with the normal line of vision of an automobile driver.”</i></p>	<p><i>at an angle in line with the center line of vision indicated at 24.”</i></p>
--	--

(Italics ours.)

Both of these quotations, by reference to their antecedent statements describe Wright's Fig. 2 (P. B. Appendix B). The first quotation declares that it is Wright's *elongated extension 14*, or the flat pillar of narrow width of the second quotation, and not the *front face* of the extension 14, which is in alignment with a line of vision of the driver and the second quotation declares that in Fig. 2 it is the *center* line of vision 24, and not the *side* line of vision 23 necessary to sustain respondent's argument, which is in such alignment. Wright's whole disclosure and his original claims 1 to 4 (R. 143) are built about this *center* line of vision 24. Wright's arguments were, in effect, directly overruled by the holding of the Court of Customs and Patent Appeals (P. B. 14) that there was inconsistency between Wright's Fig. 1 and 2 “as indicated by the projected lines of vision”.

Wright, himself, has admitted wherein the inconsistency resides, for his admission quoted on page 12 of the petition definitely states that his diamond-

shaped area of Fig. 1 has been deformed on one side, in his Fig. 2, resulting in the weakening of his post in that figure, which was obviously never intended.

Respondent's Question 2. Can an Unsuccessful Party In an Interference Proceeding Subsequently Obtain Claims Substantially the Same as Those Involved In the Interference Proceeding.

The direct answer to this question is that petitioner's claims 5 and 57 are not substantially the same as the count in Interference 61,642 as therein construed. In the decisions of all of the tribunals on priority in Interference 61,642, consideration of the patentability of the count over Carlson, when given the "latitude" expressly imposed upon it by said tribunals, was expressly refused. The holding of the Court of Customs and Patent Appeals on this point is quoted on page 13 of the petition. It has heretofore been fairly established that petitioner's "alignment" and the "substantial alignment" of the interference count are different both in structure and in function and it was so definitely held by the examiner of interferences (P. B. 14), whose decision was adopted by the Court of Customs and Patent Appeals. Moreover, Wright's belated admission that substantial alignment weakened his post (P. B. 12) definitely establishes that his "substantial alignment" is in no sense the equivalent of petitioner's "alignment" which strengthens his post. As pointed out on page 11 of the petition, *alignment* carried to its *full extent* in Wright's Fig. 2 under his admitted theory of a diamond-shaped area, would utterly destroy his post extension.

In *McBride v. Jeeple, Jr.*, 109 F. (2d) 789, it was held by the same Court of Customs and Patent Appeals that "substantially" is not the same as "completely", and this principle is applicable here if it ever was anywhere.

Respondent's brief ignores the fact that interferences are between *things* not *words*—and that it is the substance and not the shadow with which we deal (*Blackford v. Wilder*, Rev. 28, App. D. C. 535, 544). As has been aptly said, "it is not parts of speech but parts of iron and steel with which we deal".

Respondent's brief, page 7, quotes petitioner as testifying that "in none of these cases can you fix an absolute position of the driver's eye". This again is a partial quotation. The essential part of petitioner's testimony here was as follows:

"Q. That is, the full length of the post lies within the angle of vision past the post? A. The full length of the post is in line with the line of vision past it; in other words, the cross-sectional area of the post extends to and is bounded on one side for substantially its full length by the driver's line of vision, there is no angle in there.

Q. And if there were any angle between the side of the post and the side of the blind angle, that claim would not respond to such a structure, would it? A. It would not unless the angle was intended not to be there, and was so close that it really was the same thing. There must be intent. If there is a substantial angle, if the angle is very substantial, and nothing to base it on, then it certainly would not be that claim; it does not get the benefit of increased area or increased strength.

Of course, I might say in none of these cases can you fix an absolute position of the driver's eye; a big man might have a different position from a small man, but it is approximately, it is very close to the center of the seat; neither does he move his head much when he is driving, and if the designer of the post intends to give him the best vision possible by utilizing as much as possible the blind angle for the post, he is doing a very important thing, and minor deviations, where intent is present, and where the teaching is present, still insure a strong post."

The sketch, Appendix C, page 32 of the petition, shows that to obtain alignment between the face of the post in Wright's correct Fig. 1 and the driver's eye the driver must move his head through the wide angle from the line 24 to the line B which is near the side of the car and even in his erroneous Fig. 2 it would be necessary in order to obtain such alignment for the driver to move his head through the very substantial angle between the line 24 and the line D. And to what purpose? Certainly the clearness of vision would not be enhanced thereby, whereas any possible adjustment required to obtain exact alignment in petitioner's post, as exemplified in Appendix D, page 15, of this brief, would be comparatively infinitesimal and would have the great advantage that it was incident to the use of a strong post without increased obstruction to vision.

The principles here involved are most readily appreciated from a consideration of Petitioner's Physical Exhibit 2 (R. 17) which shows what Wright's disclosure would have been if he had contemplated the benefits of true alignment disclosed by petitioner's application. Physical Exhibit No. 7 (R. 28) shows in its lower section the physical embodiment of

Wright's Fig. 1 and in its hinged upper section, when expanded to its furthestmost limit, also Wright's Fig. 1, but when contracted to its innermost limit it shows Wright's Fig. 2. The white lines portray the lines of vision of Fig. 1 and the red lines the lines of vision of Fig. 2. By manipulation of this model an understanding of the questions herein raised becomes much simplified. Both Exhibits 2 and 7 are full size.

In Petitioner's Exhibit 10 (R. 45) is shown in blue the cross-section of petitioner's post and in red the cross-sections of Wright's Fig. 1 post with the details of his Fig. 2 embodied therein and also in the same color is shown a cross-section of Carlson's post. There is also superimposed on the blue post of petitioner the Emond post. All of these posts were based on a two and a half inch transverse dimension in the original Exhibit 10 and the excess of blue area on each side of the superimposed posts visually indicates the excess strength of petitioner's post over all three of the superimposed posts combined. This exhibit also shows the striking similarity of the Carlson and the Wright posts which was in fact held by the primary examiner in finally rejecting many of the Wright claims before declaration of Interference No. 61,642 (R. 148). Following this rejection Wright cancelled said claims (R. 149).

The principles of *res judicata* stated on page 7 of respondent's brief are recognized by petitioner but he submits that they are not applicable to the instant case. The suggestion of examiner that petitioner's claim 5 would be held subject to rejection in the event of an adverse decision in Interference No. 61,642 was merely a warning and not a well considered action taken after the facts determined in the interference proceedings were known. A similar notice involving

petitioner's same claim 5 was given in Interference No. 61,644, some of the counts of which Wright attempted to make and which was later consolidated with Interference No. 61,643 in which Wright was a party and in which interference petitioner prevailed. These interferences involved the subject matter of claim 5 and Interference No. 61,642 did not. Therefore, if any weight is given to this notice we submit that it would be in favor of petitioner. Moreover, since petitioner was already asserting right to the claim, the duty devolved on Wright and not on petitioner to seek an interference thereon. However, there is a more fundamental reason why petitioner could not ask that this claim be placed in interference with Wright. The Patent Office practice requires that any party seeking to add a claim to an interference must apply that claim to the structure of his opponent and show that his opponent has the right to make it, as a condition precedent to even the consideration of his motion. Here petitioner has emphatically denied Wright's disclosure of claim 5 and to have attempted to make a showing of the character indicated, in order to get said claim in the interference, he would have had to admit that Wright could make the claim and would thereafter have been estopped from challenging such right had the count been admitted to interference. Certainly no party can be required under penalty to make an admission which in good conscience he must deny.

It is submitted that claim 5 could not have been presented by applicant for interference with Wright under the provisions of Rule 109.

Conclusion.

We therefore submit that the decision of the court below does not rest upon the findings of fact which are supported by the evidence and that petitioner's questions 1 to 5 inclusive are of fundamental importance to patent rights in general and to petitioner's rights in particular. It is therefore respectfully submitted that the petition for writ of certiorari should be granted.

RICHARD E. MARINE,
Pro se.

CHARLES S. GRINDLE,
Of Counsel.

Appendix D.
(PHOTOPRINT.)

*[For the Convenience of Court and Counsel this Appendix
(Photostatic Copy) is bound in on the Opposite Page.]*

Appendix D.

FIG. A

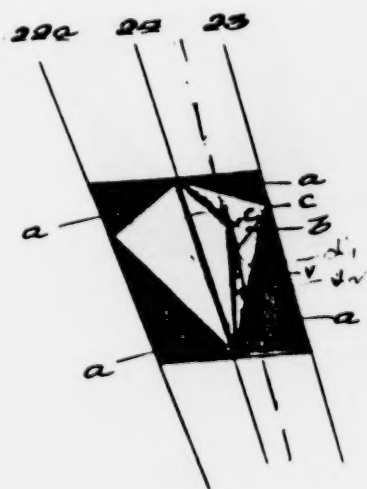


FIG. B



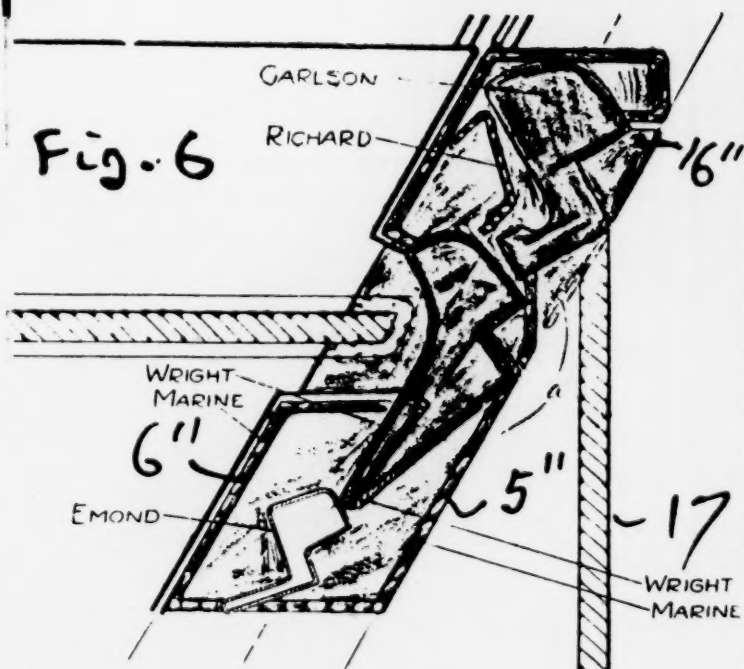


Appendix E.

(PHOTOPRINT.)

*[For the Convenience of Court and Counsel this Appendix
(Photostatic Copy) is bound in on the Opposite Page.]*

Appendix E.





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IN THE
Supreme Court of the United States

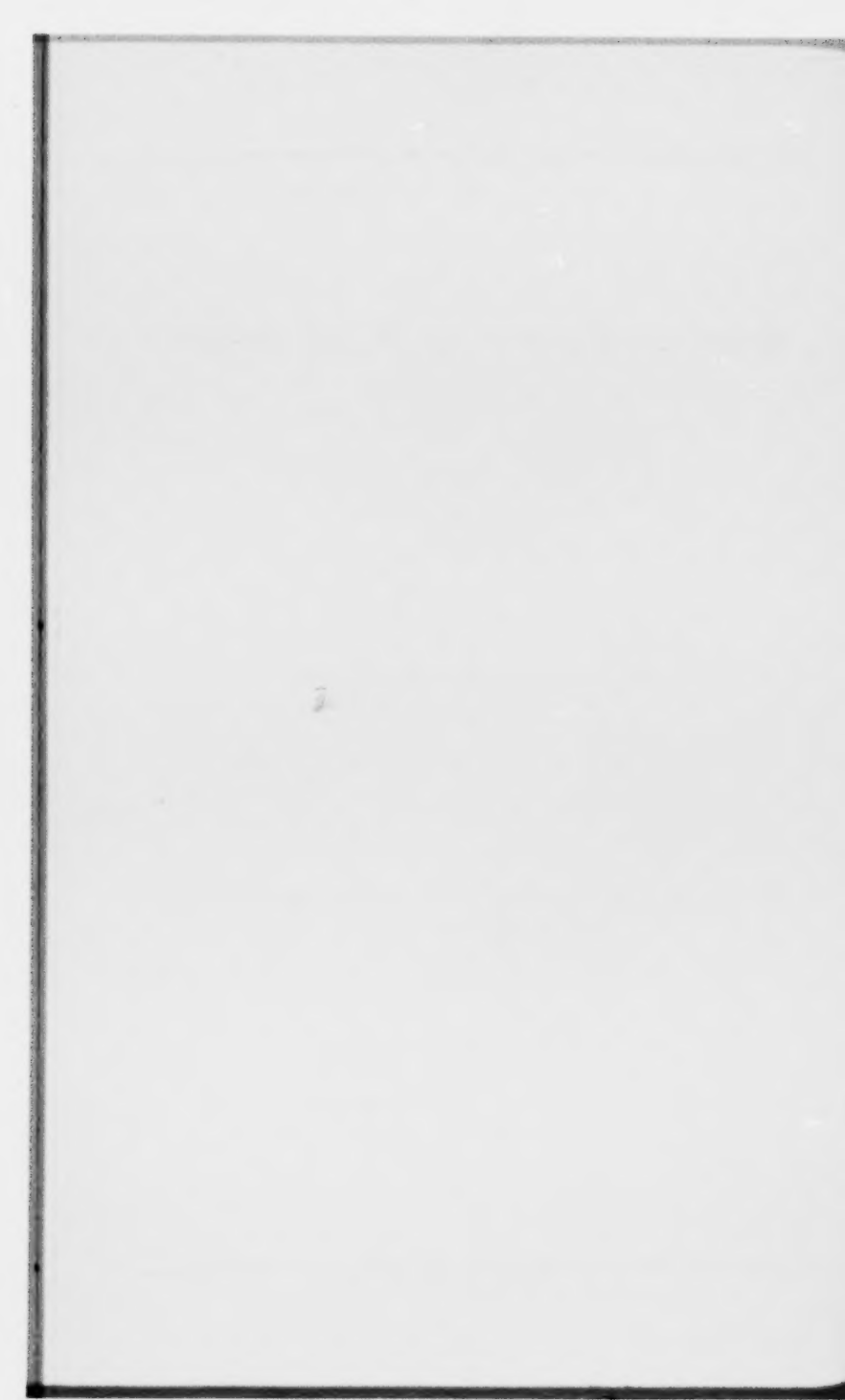
October Term, 1941.

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No. 1034.
—

RICHARD E. MARINE, *Petitioner*,
v.
CONWAY P. COE, COMMISSIONER OF PATENTS.

—
**PETITION FOR RECONSIDERATION OF PETITION
FOR CERTIORARI.**
—

RICHARD E. MARINE,
Pro Se.



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IN THE
Supreme Court of the United States

October Term, 1941.

No. 1034.

RICHARD E. MARINE, *Petitioner*,

v.

CONWAY P. COE, COMMISSIONER OF PATENTS.

**PETITION FOR RECONSIDERATION OF PETITION
FOR CERTIORARI.**

To the Honorable the Chief Justice and the Associated Justices of the Supreme Court of the United States.

Your petitioner, Richard E. Marine, *pro se*, respectfully prays for reconsideration of the decision of this Honorable Court dated April 27, 1942 (— U. S. —) denying petitioner's petition for writ of certiorari to the United States Court of Appeals for the District of Columbia, and for the allowance of the writ requested in the aforesaid petition.

FOREWORD.

The dominating reason relied upon by petitioner for the grant of this petition for reconsideration is that the United

States Court of Appeals for the District of Columbia has announced a new test of res judicata in patent cases, after interference, destructive of the inherent and inalienable rights of a losing party to an interference to improvement inventions not disclosed by his successful opponent. In so doing the court has decided a question of law of broad public importance in direct conflict with all known authority, and has so far departed from the accepted and usual course of judicial procedure as to call for the exercise of this Court's power of supervision.

This has also led the court to refuse consideration of the true merits of petitioner's case and of controlling decisions of this Court relative thereto, including newly discovered evidence determinative of the entire merits of the case, which was not before the Patent Office and which has never been passed upon by any tribunal (*PB, bottom p. 11 to bottom p. 12).

TEST OF RES JUDICATA OF LOWER COURT CONFISCATORY OF PROPERTY RIGHTS.

The test of res judicata stated by the court below is paraphrased in petitioner's question 1 (PB 18) and is as follows (R 110):

"It is considered that this interference count reads on the structure disclosed in plaintiff's claims Nos. 5 and 57, and it would, therefore, seem that such claims are disposed of adversely to the plaintiff by that litigation."

This test in effect declares that a generic claim lost by an applicant to an opponent in interference would bar claims to the applicant for a species or improvement disclosed by him but not disclosed by his opponent. This would follow because the generic claim of the interference would read on both cases.

* Petitioner's main brief.

Res judicata cannot thus create a new statutory bar to patentability but must rest upon anticipation by actual disclosure in the opponent's case. It can create no bar more than can a prior patent, and the statutes (R. S. 4886 and 4888, PB 35), which provide for the grant of improvement patents, are abrogated by the test announced by the Court.

Reference to Fig. A, Appendix D, page 14, of petitioner's reply brief, shows that the white area, representing the cross-sectional area of Wright's Fig. 2, solely relied upon by respondent to anticipate petitioner's appealed claims 5 and 57, is much weaker than the white, gray and black areas, representing the total area and strength of petitioner assembly, (PRB 10 and 11). Even disregarding the lack of utility admitted by Wright for his Fig. 2 construction (PB 12) it is obvious that petitioner's improvement is more inventive than Wright's Fig. 2 step backward, and therefore the latter can not be res judicata as to the former.

TRUE TEST OF RES JUDICATA ESTABLISHED BY SUPREME COURT.

The test of res judicata, or estoppel by former judgment, herein adopted by the courts below is inconsistent with that established by the decisions of this Court. In *Southern Pacific Railroad v. United States*, 168 U. S. 1, 48, this Court said:

"The general principle announced in numerous cases is that a right, question or fact distinctly put in issue and directly determined by a court of competent jurisdiction, as a ground of recovery, cannot be disputed in a subsequent suit between the same parties or their privies; and even if the second suit is for a different cause of action, the right, question or fact once so determined must, between the same parties or their privies, be taken as conclusively established, so long as the judgment in the first suit remains unmodified."

To the same effect are the decisions of this Court in *Russel v. Place*, 94 U. S. 606, 608; *Nesbit v. Riverside*, 144 U. S.

610, 618, and *New Orleans v. Citizens' Bank*, 167 U. S. 371, 396-7. In *Russel v. Place* two claims of the same patent were held to constitute two different causes of action.

Applying this test to appealed claims 5 and 57 which are predicated upon the saving of the waste spaces, shown by the black areas, on one side of the assembly by effecting true alignment between the outer side of such areas and, say, the line of vision 23, it is apparent that the question of their patentability is not *res judicata* by reason of the "substantial" alignment between the right hand face of the white area representing Wright's erroneous Fig. 2, and the dotted line of vision through its apex c, which was the subject matter of the count awarded to Wright in Interference No. 61642.

LOWER COURT'S TEST OF RES JUDICATA IGNORES OTHER PRINCIPLES ESTABLISHED BY SUPREME COURT.

It also follows that the lower court erred (R 110) in "laying aside" the "geometry" of Wright's erroneous (PB 9, last par.) Fig. 2. Likewise it erred in holding that the "reasoning employed by the Court of Customs and Patent Appeals" compelled the holding of *res judicata* here (PB 14).

The danger inherent in the test of *res judicata*, for the first time laid down by the lower court, cannot be unduly emphasized. Even the established tests of *res judicata*, as applied in office practice, has great potentiality for injury to a meritorious inventor, after interference with a less meritorious opponent who is awarded priority on the basis of hyper-technical rules of construction of claims (PB 18, 19, Qs. 2 to 5), already condemned by this Court (PB 20 to 22).

It frequently occurs that the successful party to an interference obtains claims which he might not have obtained had the interference never existed and, conversely, due to the harsh and technical application of the principle of *res judicata*, the losing party obtains with great difficulty, if at all, protection of his legitimate property rights which would

not have been denied him had his opponent's case been prior art and no interference had ever existed. No logical reason exists for this result, which is doubtless due, in part, to the reluctance of the examiner, on *ex parte* action on new claims submitted by the losing party after the interference, to risk an interpretation of the decisions rendered in the interference by higher tribunals. On *ex parte* appeals thereafter the appellate tribunals frequently affirm on the theory of concurrent decisions. That these hyper-technical rules of procedure should be discouraged is the firm conviction of petitioner, based in part upon three years' experience in the Interference Division and seven years on the Board of Appeals of the Patent Office (R 47).

NEW AND CRITICAL EVIDENCE AFTER TERMINATION OF INTERFERENCE SHOULD BAR RES JUDICATA AND DETERMINE CASE.

The instant suit was an original action under R. S. 4915, and we submit, should have been decided by the lower court on the entire record, and especially so in the light of newly discovered evidence in the nature of an admission by Wright in his application record made after termination of Interference No. 61642 and therefore not available to petitioner during the progress of Interference No. 61642.

It is submitted that this admission is determinative of all the issues in the case (PB 10-12).

CONCLUSION.

For the reasons stated, it is submitted that the petition for rehearing should be granted and that the decision of the court below should be reviewed and reversed, and that a writ of certiorari should be granted to that end.

Respectfully,

RICHARD E. MARINE,
Pro Se.

May 22, 1942.

I hereby certify that the foregoing petition is presented in good faith and not for purpose of delay.

RICHARD E. MARINE.

End

